SUPREME COURT, U. S.

Supreme Court, U. S.
FILED
FEB 13 1975
MICHAEL RODAK, JR., CLERK

No. 74-892

In the

Supreme Court of the United States

SKIL CORPORATION,

Petitioner.

vs.

LUCERNE PRODUCTS, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

JAMES VAN SANTEN,
LEWIS T. STEADMAN,
HILL, GROSS, SIMPSON, VAN SANTEN,
STEADMAN, CHIARA & SIMPSON
70th Floor - Sears Tower
233 S. Wacker Drive
Chicago, Illinois 60606
(312) 876-0200
Attorneys for Lucerne Products, Inc.

Of Counsel:
REESE DILL,
MERKEL, CAMPBELL, DILL & ZETZER
2150 Illuminating Building,
Cleveland, Ohio 44113
and
RICHARD J. EGAN,
BALDWIN, EGAN, WALLING & FETZER
1430 Keith Building
Cleveland, Ohio 44115

The Scheffer Press, Inc.—(312) 263-6850

TABLE OF CONTENTS

PAGE

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI 1

Introduction 1

Supplemental Statement of Fact 1

The District Court Litigation 2

The District Court Decision 2

Court of Appeals Decision 5

CITATIONS

CASES

A & P Tea Co. v. Supermarket Corp., 340 U.S. 147, 152-153 (1950) 6

Blonder-Tongue Laboratories v. University of Illinois Foundation, 402 U.S. 313, 91 S.Ct. 1434, 28 L.Ed.2d 788 (1971) 7

Graham v. John Deere Co., 383 U.S. 1, 17 (1966) 6

Westward Chemical Inc. v. Molded Fiber Glass Body Co., 498 F.2d 1115 (C.A. 6, 1974) 7

STATUTES

35 U.S.C. §102 ..... 2, 3

35 U.S.C. §103 ..... 2, 3

OTHER

35 U.S.C.A. §282, note 38 7

IN THE
SUPREME COURT OF THE UNITED STATES

No. 74-892

SKIL CORPORATION,

Petitioner,

vs.

LUCERNE PRODUCTS, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

INTRODUCTION

There is a complete absence of a significant federal question warranting the supervisory intervention of this Court.

The District Court committed reversible error which the Court of Appeals properly corrected in accordance with the recognized mandates of this Court.

SUPPLEMENTAL STATEMENT OF FACT

The paths of petitioner, Skil, and respondent, Lucerne, crossed in 1964, when Skil contracted to purchase 100,000 trigger-operated speed controls from Lucerne for installation in portable Skil drills.

The pre-1965 Lucerne switch furnished to Skil by Lucerne had all of the basic elements illustrated and described in the C.A. 7 decision (A 14a).

Skil management decided Skil drills needed the capability of adjustability and gave the project of making the Lucerne switch adjustable to Carl Frenzel, a Skil engineer.

Frenzel's improvement, in substance, consisted of changing the pre-1965 Lucerne switch by adding an adjustment screw and interposing a separate stop member between the trigger and the housing (A 14a).

THE DISTRICT COURT LITIGATION

The issues of infringement and validity were tried before the District Court on independent claims 2 and 3 and dependent claim 5 of the Skil patent. Claim 1, on which subordinate claim 5 was dependent, was also considered and invalidated by the District Court.

THE DISTRICT COURT DECISION

The District Court invalidated claims 1 and 2 of the Skil Patent U.S. Reissue 26,781 over a record reference (Sparklin U.S. Patent 2,525,839) cited and considered by the U.S. Patent Office during the course of prosecution of the Skil patent, thereby reflecting a legal conclusion on the part of the District Court that the Patent Office had not correctly applied the standards of invention prescribed in both Sections 102 and 103 of the Patent Statute of 1952 (35 U.S.C.):

> "Sparklin's invention is incapable of achieving this result, but it does preclude claims 1 and 2 of Frenzel's patent on the ground of obviousness, (§103) if not complete anticipation (§102) [A. 3a, col. 1]

Significantly, the District Court further invalidated claim 3 over a 1957 public use and sale of an Ingersoll-Rand Impactool, which evidence was *not* before the U.S. Patent Office during the course of prosecution of the Skil patent application. While the District Court articulated such determination of invalidity in terms of obviousness (§103) (A-3a), it is apparent from a most cursory reading that the District Court would have been entirely correct in applying the §102 "novelty" test since each and every recited requirement of claim 3, *i.e.*, base claim 1 + dependent claim 3, finds a full and complete response in the 1957 Ingersoll-Rand Impactool.

The District Court also overlooked the necessity of determining the quantum of invention exhibited by claim 5 over the non-cited prior art evidence represented by the pre-1965 Lucerne switch and the Ingersoll-Rand Impactool (A 14a, particularly footnote 1).

Had the District Court scrutinized claim 5, without erroneously according to it an unwarranted presumption of validity over non-cited art, it would have been compelled to find that claim 5 had the same lack of novelty (§102) and the same degree of obviousness (§103) as invalid claim 2 since claim 5 is directed to essentially the same combination of elements as invalid claim 2:

"Recitations of invalid Claim 2	Recitations of Claim 5
In a portable tool having a trigger receiving housing aperture	The switch device [according to claim 1] In a portable tool having a trigger receiving housing aperture,
wherein the tool is of the type having a control sys-	wherein the tool is of the type adapted to contain a

tem capable of varying the speed of the tool motor in response to the amount of trigger movement,

control system capable of varying the speed of the tool motor in response to the amount of trigger movement,

a trigger actuated electric switch device for mounting in said tool with the trigger extending through said aperture for manual depression

a trigger actuated switch device for mounting in said tool with the trigger extending through said aperture for manual depression,

said switch device comprising,

said switch device comprising,

a casing,

a casing,

and a trigger mounted thereby for oscillating movement

a trigger mounted by the casing for oscillating movement,

said device also including resilient means interposed between said casing and said trigger for urging the latter to its extended position,

resilient means carried by the casing and engaged with the trigger for urging the same to its extended position,

abutment means carried by said casing,

[and abutment means on said casing]

adjustment means carried by said trigger including an element movable relative to the latter to and away from said abutment

said trigger including guide means extending in parallel relation with the direction of trigger movement,

means along a path corresponding to the path of movement of the trigger,

lug means carried by said trigger and engaged with said guide means for movement in either direction therealong, a manually operable adjustment means including a member rota-

tably carried by the trigger and engaged with said lug means for moving the same in either direction along said path of movement thereof,

said element being arranged to abut said abutment means upon depression of the trigger thereby to limit the amount of movement of the latter for establishing a selected speed of the tool motor,

and abutment means on said casing arranged to be engaged by said lug means upon depression of the trigger thereby to limit the amount of movement of the latter for establishing a selected speed of the tool motor

said device including locking means engageable with said element for locking said trigger in any one of its positions determined by engagement of said element with said abutment means.

further defined by, trigger locking means including a locking pin, which locking means is mounted on said casing for extending through a bore in the tool housing thereby to expose said pin for manual depression, catch means carried by said lug means and adapted to be releasably locked by said pin when the catch means is aligned with the pin."

COURT OF APPEALS DECISION

The Court of Appeals did *not,* as charged by Petitioner, test dependent claim 5 against its admittedly invalid parent patent claim 1, or invalid companion claim 2. It examined and properly followed the mandates of this

Court in *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966) by studying the record and the decision of the District Court as it pertained to:

(1) The status of the prior art.

(2) The differences between claim 5 and such prior art.

(3) The level of ordinary skill in the art.

As to (3), the level of ordinary skill in the art, C.A.7 noted the absence of a specific District Court finding (A 16a), but justifiably concluded on the basis of the record that it was apparent:

> ". . . the designing of portable electric tools is a crowded art in which there is a high level of ordinary skill." (A 16a)

As to (1) and (2), C.A. 7 properly analyzed that with respect to the state of the prior art (1), the locking pin and a rectangular depression in the trigger was already in the pre-1965 Lucerne switch (*not* cited by the Patent Office), and with respect to the differences of claim 5 over the prior art (2), there is a locking pin which cooperates with a hole in the stop member (A 16a).

That alleged "improvement" was concluded to be obvious, a conclusion applied pursuant to the mandate of the *A & P* Case to:

> ". . . scrutinize combination claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." *A & P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 152-153 (1950). (A 16a)

C.A. 7 also reinforced that conclusion by noting the anticipatory Singer Company evidence, which was *not*

cited to the Patent Office (A 16a), and which shows a complete anticipation of claim 5.

There is no statutory presumption of validity as to anticipatory art not cited before the U.S. Patent Office. See 35 U.S.C.A. §282 note 38. Thus, the 1957 Ingersoll-Rand Impactool, the pre-1965 Lucerne switch and the 1965 Singer Company evidence is all anticipatory non-cited art which C.A. 7 properly considered in reversing the District Court. The errors committed by the District Court were apparent within the four corners of its own decision, but were even more glaringly exposed by the articulate reasoning of the Court of Appeals as embodied in its decision.

Assuming arguendo that C.A. 7 did test dependent claim 5 against other admittedly invalid claims, respondent submits that such procedure would not be reversible error. Cf. *Westwood Chemical Inc.* v. *Molded Fiber Glass Body Co.*, 498 F.2d 1115 (C.A. 6, 1974). In that case C.A. 6 recognized in examining a *Blonder-Tongue* problem (collateral estoppel), that multiple patent claims oftentimes present identical questions of fact. For example, unadjudicated claims sometimes merely restate, without significant difference, an adjudicated claim. C.A. 6 interpreted the instructions of this Court in applying the collateral estoppel doctrine of *Blonder-Tongue* that it was proper to compare patent claims. *Blonder-Tongue Laboratories* v. *University of Illinois Foundation*, 402 U.S. 313, 91 S.Ct. 1434, 28 L.Ed. 2d 788 (1971).

In *Blonder-Tongue* this Court characterizes the problem of patent claim interpretation in terms of "issues" and "questions". It is clear from the decision of C.A. 7, for which review is sought, that respondent Lucerne fully discharged its burden in establishing that in terms

of "issues" and "questions" claim 5 was just as invalid as invalid claims 1, 2 and 3. Regardless of how C.A. 7 explained the final result, Petitioner has failed to persuade C.A. 7 that its patent embodies "patentable invention".

The petition for certiorari should be denied.

Respectfully submitted,

JAMES VAN SANTEN,
LEWIS T. STEADMAN,
HILL, GROSS, SIMPSON, VAN SANTEN,
STEADMAN, CHIARA & SIMPSON
70th Floor - Sears Tower
233 S. Wacker Drive
Chicago, Illinois 60606
(312) 876-0200-
Attorneys for Lucerne Products, Inc.

Of Counsel:

REESE DILL,
MERKEL, CAMPBELL, DILL & ZETZER
2150 Illuminating Building,
Cleveland, Ohio 44113

and

RICHARD J. EGAN,
BALDWIN, EGAN, WALLING & FETZER
1430 Keith Building
Cleveland, Ohio 44115